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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,186	11/21/2003	Joao Alfredo Monteiro Luna	29269-03	3242

7590

08/24/2005

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,186

Applicant(s)

LUNA ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/934,730.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Claims 1, 3-6, 8 and 9 are pending in the application, claims 2 and 7 have been cancelled.
2. Amendments to the claims, filed on May 31, 2005, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The objection to claim 4, made of record in the office action mailed February 24, 2005, page 2, paragraph #4 has been withdrawn due to Applicant's amendment in the response filed May 31, 2005.
4. The 35 U.S.C. §112 rejections of claims 2, 4, 7 and 8, made of record in the office action mailed February 24, 2005, pages 2-3, paragraph #4 have been withdrawn due to Applicant's amendment in the response filed May 31, 2005.
5. The 35 U.S.C. §102 rejection of claims 1, 2 and 4-8 over Viby (WO 99/31644), made of record in the office action mailed February 24, 2005, pages 3-5, paragraph #6 has been withdrawn due to Applicant's amendment in the response filed May 31, 2005.
6. The 35 U.S.C. §103 rejection of claim 3 as over Viby in view of Schliesman et al. (US Patent No. 6,129,785), made of record in the office action mailed February 24, 2005, page 6, paragraph #8 has been withdrawn due to Applicant's amendment in the response filed May 31, 2005.

REJECTIONS

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

8. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "special paper" in claim 9 is unclear and renders the claim vague and indefinite. It is unclear what constitutes a "special" paper. For purposes of examination any paper is deemed to meet the limitation "special."

Claim Rejections - 35 USC § 102

9. Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by McKillip (U.S. Patent No. 5,219,183).

Regarding Applicant's claim 1, McKillip discloses a digital photographic product (*printable sheet, title*) comprising a liner (*backing sheet, col. 3, lines 6-7*), an adhesive adhered to the liner (*col. 3, line 7 and figure 2*) and a photographic paper (*separable card, col. 2, line 54*) releasibly carried by the adhesive (*figure 1*).

Regarding the limitation "photographic paper", the Examiner has given the term the broadest reasonable interpretation consistent with the written description in Applicant's specification as it would be interpreted by one of ordinary skill in the art. MPEP 2111. The

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specification implies that “photographic paper” is paper that is capable of receiving ink/toner such as from an ink-jet printer (*specification page 7, paragraph 25 and claim 1*). Therefore, the Examiner has given the term “photographic paper” the broadest reasonable interpretation in light of the specification, a paper that is capable of receiving ink/toner. McKillip’s sheet meets this limitation because it is printed on by a laser printer (*col. 1, line 43*), i.e. it is a sheet that received ink/toner from a laser printer.

The photographic paper has a continuous, uninterrupted half-cut extending through the photographic paper but not through the liner (*rectangular cut lines, col. 3, line 18*), which is deemed to define a photograph area (*separable card, col. 2, line 54*). The photograph area is smaller than a photographic image to be printed on the photographic paper (*see comment below*) by a printer and leaving a marginal portion outside of the photographic area (*figure 1*).

Regarding the limitation “photograph area smaller than a photographic image to be printed on said photographic paper by an ink jet printed”, the Examiner has given the term the broadest reasonable interpretation consistent with the written description in Applicant’s specification as it would be interpreted by one of ordinary skill in the art. MPEP 2111. The Examiner has interpreted this limitation to mean that the photograph area is smaller than the area of the entire photographic paper, since printers of all types are capable of printing over the entire paper. As seen by figure 1 of McKillip the separable card is smaller than the area of the printing paper.

The limitation “when said photographic image is printed on said photographic paper using said inkjet printer” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed

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intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, it is noted that McKillip does disclose that the printable sheets can be printed on by a laser printer (*col. 1, line 43*).

Furthermore, the limitation “said photographic image including a safety margin as part of said photographic image” is a limitation that further limitations the above cited intended use limitation. As stated above a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. MPEP § 2111.02. Furthermore, it is noted that McKillip does disclose the photographic paper has a marginal portion out (*figure 1*) said the photograph area (*separable card, col. 2, line 54*), and thus provides the structure on the paper for the safety margin.

The photograph area can be peeled from the marginal portion of the photographic paper (*figure 1*) and the adhesive to produce a photograph having smooth edges and no adhesive adhered to the photograph (*figure 1 and col. 3, lines 30-32*).

Regarding Applicant’s claims 5 and 6, these claims contain method limitations. Method limitations do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because McKillip discloses the same product structure, see above discussion of claim 1.

Claim Rejections - 35 USC § 103

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip as applied above, and further in view of Schliesman et al. (U.S. Patent No. 6,129,785).

McKillip is relied upon as described above.

McKillip fails to disclose that the weight of the liner is less than the weight of the photographic paper.

Schliesman discloses that ink jet recording medium can be a paper from light weight Bible paper to heavy specialty papers (*col. 6, lines 12-21*).

McKillip and Schliesman are analogous because they both disclose printer recording medium.

Therefore, the exact weight of the photographic paper, i.e. ink jet recording medium, and liner is deemed to be a result effective variable with regard to the intended use, such as business cards (*Klein, col. 1, line 20*) . It would require routine experimentation to determine the optimum value of a result effective variable, such as paper weight, in the absence of a showing of criticality in the claimed paper weight. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by use a heavier weight photographic paper and thus lighter by comparison liner because heavier photographic paper would provide sturdier business cards, i.e. that will not tear as easy.

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11. Claims 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip as applied above, and further in view of Klein (U.S. Patent No. 5,007,191) and Viby (WO 99/31644).

McKillip discloses a digital photographic product (*printable sheet, title*) comprising a liner (*backing sheet, col. 3, lines 6-7*), an adhesive adhered to the liner (*col. 3, line 7 and figure 2*) and a photographic paper (*separable card, col. 2, line 54*) releasibly carried by the adhesive (*figure 1*). Furthermore, the product comprises a “special paper” since the reference discloses the face sheet with separable cards is capable of being feed through a laser printer and will not cause jamming or other malfunctions (*col. 1, lines 52-57*). A sheet that will not jam a printer is deemed to be special.

Regarding the limitation “photographic paper”, the Examiner has given the term the broadest reasonable interpretation consistent with the written description in Applicant’s specification as it would be interpreted by one of ordinary skill in the art. MPEP 2111. The specification implies that “photographic paper” is paper that is capable of receiving ink/toner such as from an ink-jet printer (*specification page 7, paragraph 25 and claim 1*). Therefore, the Examiner has given the term “photographic paper” the broadest reasonable interpretation in light of the specification, a paper that is capable of receiving ink/toner. McKillip’s sheet meets this limitation because it is printed on by a laser printer (*col. 1, line 43*), i.e. it is a sheet that received ink/toner from a laser printer.

The photographic paper defining a photographic printing area *separable card, col. 2, line 54*) and has a continuous, uninterrupted half-cut extending through the perimeter defining a

rectangle according to the size of the information to be printed (*figure 1*). The half-cut defining a marginal portions outside of the photographic area (*figure 1*).

Regarding the limitations “for use in an inkjet printer,” “proper to printing a photograph thereon,” and

“so that, when a photographic image is printed on said photographic area, said photograph can be peeled from said liner and said adhesive, leaving said marginal portion of said photographic paper”, are deemed to be statements with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The photograph area can be peeled from the marginal portion of the photographic paper (*figure 1*) and the adhesive to produce a photograph having smooth edges and no adhesive adhered to the photograph (*figure 1 and col. 3, lines 30-32*).

McKillip fails to disclose the photograph area has rounded corners.

Klein teaches a business card (*title*) in the shape of a rectangle with rounded corners (*figure 11*).

Viby teaches an id card in the shape of a rectangle with rounded corners (*figure 2*).

It would have been an obvious matter of design choice to change the shape of McKillip’s card to include rounded corners, since a modification would have involved a mere change in shape of the corners of the card. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments in the response filed May 31, 2005 regarding the 35 U.S.C. 112, 102 and 103 rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alicia Chevalier', with a stylized, cursive script.

Alicia Chevalier

8/18/05